

REMARKS

Claims 1 and 21-25 are currently pending and under examination.

The rejections will be addressed in the order set forth in the Office Action mailed September 30, 2005.

Obviousness type double patenting

The provisional rejection of the instant claims for alleged obviousness type double patent over claims 21-27 of co-pending Application No. 10/062,738 has been maintained. The Examiner alleges that no Terminal Disclaimer has been filed. However, a terminal disclaimer over Application Number 10/062,738 was submitted with the terminal disclaimers over U.S. Patent Nos. 6,365,797, 6,107,540, 6,828,471, and 6,815,574 provided with Applicants' response filed July 18, 2005. A copy of the previously filed Terminal Disclaimer is provided herewith. In view of the filing of the Terminal Disclaimer, Applicants respectfully request withdrawal of the rejection.

Rejection under 35 U.S.C. § 102(b)

Claims 1, 24, and 25 were rejected as allegedly anticipated by Stearns and Wang (*Cancer Res.* 52:3778-3781, 1992, referred to herein as "Stearns"). The Examiner describes Stearns as disclosing experiments using a SCID mouse model in which PC-3 human prostatic tumor cells were injected intravenously into the tail vein. Fifteen days and twenty days after treatment with taxol (or control vehicle), animals were examined for tumors. Tumors were present in the lumbar vertebrae. The Examiner alleges that Stearns therefore anticipates the invention set forth in claims 1, 24, and 25.

As the Examiner knows, in order for a reference to anticipate a claim, each element of the claim at issue must be present. In Stearns, the cells are injected intravenously into the tail vein of the animal. In order to expedite prosecution, claim 1 has been amended to recite that the xenograft is implanted subcutaneously, intrapostatically or within a bone of the mouse and to recite that the model exhibits the transition from androgen-dependence to

androgen-independence. Stearns does not disclose these elements. Thus, the rejection is obviated by the amendment to claim 1. Applicants therefore respectfully request its withdrawal.

Rejections under 35 U.S.C. § 103

Claims 1, 21, 24, and 25 were rejected as allegedly obvious over Stearns in view of Crowley *et al.* (*Proc. Natl. Acad. Sci. USA* 90:5021-5025, 1993). The Examiner describes Crowley as teaching subcutaneous implantation of PC3 prostate carcinoma cells into nude mice and subsequent identification of metastatic loci in lymph nodes, femurs, lungs, and brain. The argument alleges that it would have been obvious to use a SCID mouse model for prostate cancer as taught by Stearns and subcutaneously implant the xenograft because Crowley supports that producing their mouse model using a subcutaneous xenograft allows the metastasis of human tumor cells. To the extent that the rejection applies to the amended claims, Applicants respectfully traverse.

As noted above, claim 1 has been amended to recite that the mouse model exhibits the transition from androgen-dependence to androgen-independence. Stearns does not teach or suggest this element. Crowley offers no teachings that remedy this deficiency. Accordingly, the claims are unobvious over the cited art. Applicants therefore respectfully request withdrawal of the rejection.

Claims 1, 22, 24, and 25 were rejected as allegedly obvious over Stearns in view of U.S. Patent No. 5,491,284. To the extent that the rejection applies to the amended claims, Applicants again respectfully traverse. U.S. Patent No. 5,491,284 provides no teachings or suggestions that remedy the deficiencies of Stearns. Accordingly, the claims are patentable over the art. Applicants therefore respectfully request withdrawal of the rejection.

Appl. No. 10/067,705
Amdt. dated January 5, 2006
Reply to Office Action of September 30, 2005

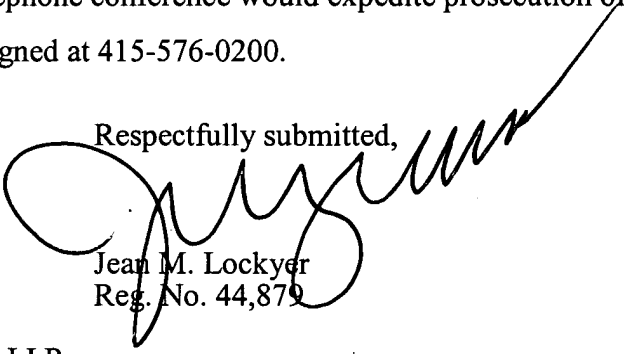
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CONCLUSION

In view of the foregoing, Applicants believe all claims now pending in this Application are in condition for allowance. The issuance of a formal Notice of Allowance at an early date is respectfully requested.

If the Examiner believes a telephone conference would expedite prosecution of this application, please telephone the undersigned at 415-576-0200.

Respectfully submitted,


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